

REMARKS

Entry of this Amendment and reconsideration are respectfully requested in view of the amendments made to the claims and for the remarks made herein.

Claims 1-10 are pending and stand rejected.

Claims 1, 7 and 9 are independent claims.

Claims 1, 7 and 9 have been amended.

Claims 1-4 and 6-9 stand rejected under 35 USC 102(b) as being unpatentable over Abe (USP no. 6, 381, 208). Claims 5 and 10 stand rejected under 35 USC 103(a) as being unpatentable over Abe in view of Tsukagoshi (USPPA 2002/0018438).

Claims 1-4 and 6-9 stand rejected under 35 USC 102(b) as being unpatentable over Abe. In maintaining the rejection of the claims, the Office Action states that "Abe describes a possibility of replacing the average thickness value with thickness values which the examiner views as a profile (col. 4, lines 55-63)." (see OA, page 2).

Applicant respectfully disagrees with and explicitly traverses the reason for rejecting the claims. However, in order to advance the prosecution of this matter, applicant has elected to amend the independent claims to further recite the thickness profile being determined based on a specific lacquer formulation of the transparent layer and a rotational speed used in the formation of the transparent layer. No new matter has been added. Support for the amendment may be found at least on page 4, lines 24-27.

Abe discloses a system wherein information regarding a transparent layer is contained in two areas. The first area includes an average thickness value and the second area including information corresponding to a local thickness value at respective points within the transparent layer. The local thickness values, which may be deviations from the average thickness value, are determined after the disk is manufactured and written into a writeable area. The local thickness values are combined with the average value to determine a thickness values at a corresponding location.

In col. 4, lines 55-65, Abe discloses that the local values are obtained after

manufacturing. In describing the replacement of the average thickness with the thickness of the transmitting layer at a plurality of arbitrary positions, Abe fails to provide any specific discussion of how the plurality of thickness values may be written in place of the average value.

From the teaching of Abe with regard to using an average value and the local values, skilled in the art would understand that the plurality of thickness values used to replace the average value, are obtained after the manufacture of the disk as the plurality of thickness values may be obtained from inspection of the created disk. The thickness values would then be used in place of the average thickness value, such that intermediate thickness values at different positions may be obtained or determined with reference to the thickness value closest to the intermediate thickness value, for example.

One skilled in the art would understand that the profile described in the independent must be prepared prior to the manufacture of the disc as the profile is stored in a read-only area, as is recited in the claims. Thus, the plurality of thickness values described by Abe is not comparable to the profile recited in the claims as Abe describes or suggests that these values must be obtained after the manufacture process and not before the disc is manufactured, as is recited in the claims.

Even if it could be said that the plurality of thickness values is comparable to the profile recited in the claims, Abe fails to disclose that the profile (plurality of thickness values at arbitrary positions) is determined based on the lacquer formulation of the thickness layer and a specific disc rotation used in forming the transparent layer, as is recited in the claims.

A claim is anticipated if and only if each of the elements recited in the claims is recited in a single prior art reference.

Abe cannot be said to anticipate the subject matter claimed in each of the independent claims, as Abe fails to teach a material element recited in the claims.

For the amendments made to the claims and for the remarks made herein, applicant submits that the reason for the rejection of the independent claims, and the claims dependent therefrom, has been overcome.

Claims 5 and 10 stand rejected under 35 USC 103(a) as being unpatentable over

Abe in view of Tsukagoshi (USPPA 2002/0018438).

Applicant respectfully disagrees with and explicitly traverses the rejection of the claims. Claims 5 and 10 depend from independent claims 1 and 9, which have been shown to include subject matter not disclosed by Abe. Tsukagoshi fails to provide any teaching to correct the deficiency found to exist in Abe.

Hence, the combination of Abe and Tsukagoshi fails to disclose a material element recited in the independent claims, and consequentially, in the aforementioned dependent claims.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

The combination of Abe and Tsukagoshi fails to render obvious the invention recited in claims 5 and 10, as neither Abe nor Tsukagoshi provides any teaching with regard to forming the profile based on a given lacquer formulation and a specific rotation speed, as is recited in the claims.

Applicant submits that the rejection of the subject matter recited claims 5 and 10 has been overcome.

For the amendments made to the claims and for the remarks made herein, applicant submits that all the objections and rejections have been overcome and that the claims are in a condition for allowance. Withdrawal of the rejections of the claims and the issuance of a Notice of Allowance is respectfully requested.

Should the Examiner believe that the disposition of any issues arising from this response may be best resolved by a telephone call, the Examiner is invited to contact applicant's representative at the telephone number listed below.

Respectfully submitted,
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